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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,494	03/18/2005	Enrico Maim	15675P538	8268

8791 7590 07/13/2007
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EXAMINER

LE, MICHAEL

ART UNIT PAPER NUMBER

2163

MAIL DATE DELIVERY MODE

07/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/501,494

Applicant(s)

MAIM, ENRICO

Examiner

Michael Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 1-27 and 37-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Summary and Status of Claims

1. This Office Action is in response to Applicant's reply filed April 27, 2007.
2. Claims 1-52 are pending.
3. Claims 1-27 and 37-52 are withdrawn from consideration as being directed to a non-elected invention.
4. Claims 28-36 have been considered on the merits.
5. Claims 28-36 are rejected under 35 U.S.C. 112, second paragraph.
6. Claims 28-36 are rejected under 35 U.S.C. 101.
7. Claims 28-33 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Emens et al. (US Patent 6,832,218).
8. Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens et al. (US Patent 6,832,218), in view of Kolluri et al. (US Patent Pub 2003/0101286).
9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

10. **Claim 35 is objected to** because of the following informalities:
11. **Claim 35** recites "the first resources" in line 3. There is only one "first resource" therefore it should be changed to --the first resource--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

12. **Claims 28-36 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. **Claim 28**, recites the limitation “displaying signaling information distinct from the display of said other resource itself signaling of the existence of said first resource” in step c). The limitation is unclear. The Examiner is unable to determine the meaning of the limitation from the language of the claims or after a review of the Specification.

14. **Claim 28** recites “herewith” in step c). It is unclear what “herewith” refers to. It could potentially refer back to the second resource or an “other relevant resource”. The Examiner interprets “herewith” to refer to the second resource.

15. **Claim 33** recites “a server adapted to execute” in line 3. The clause “adapted to” is not limiting language and makes the step optional. Applicant is requested to amend the language of the claim to a position recitation. *See* MPEP 2111.04.

16. **Claim 34** recites “relevance scoring process is adapted to identify” in lines 2-3. The clause “adapted to” is not limiting language and makes the step optional. Applicant is requested to amend the language of the claim to a position recitation. *See* MPEP 2111.04.

17. **Claim 35** recites “representations of links to at least certain among the first resources forming said signaling information” in lines 2-3. The limitation is unclear. Specifically, the

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phrase “at least certain” is unclear. The Examiner is unable to determine the meaning of the limitation from the language of the claims or after a review of the Specification.

18. **Claims 19-32 and 36** are rejected because they depend on a rejected claim. Dependent claims contain the limitations of the parent claims and are therefore rejected for the same reasons.

19. The prior art rejections to claims 28-36 below are made as best understood in light of the rejection under 35 U.S.C. 112, second paragraph addressed above.

Claim Rejections - 35 USC § 101

20. **Claims 28-36 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter.

21. The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must produce a useful, concrete and tangible result.

22. In the present case, **claims 28-36** recite a method but the method has an open-ended result. In particular, the method produces a result only upon satisfying a condition. The condition occurs in the last limitation, “if the second resource with respect to other relevant resources has the first identifier herewith...” Such a result, produced based on a condition, results in an open-ended result, which means it does not produce a result if the condition is not

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satisfied. Thus, if the condition is not satisfied, the claimed method does not pass muster and is nonstatutory. Because the claims are potentially nonstatutory, they are rejected as nonstatutory.

23. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to overcome the rejection.

Claim Rejections - 35 USC § 102

24. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

25. **Claims 28-33 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Emens et al. (US Patent 6,832,218) hereinafter “Emens”.**

26. In regards to **claim 28**, Emens discloses a method of managing information resources in a computer system, the method comprising the steps of:

- a. receiving user information from a user input device (Emens at col. 4, lines 6-8), said user information is representative of a declaration that a second resource accessible by the computer system should be associated with a first resource accessible by the

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computer system (Emens at col. 4, lines 11-7), and storing in association with said second resource an identifier of said first resource (Emens at col. 4, lines 17-21)¹;

b. identifying other resources accessible by the computer system that are relevant with respect to said second resource by a relevance scoring process (Emens at col. 4, lines 12-4, 52-7)²; and

c. determining whether the second resource with respect to other relevant resources has a first identifier associated herewith when one of said other resources is to be accessed by the computer system for display, and displaying signaling information distinct from the display of said other resource itself signal of the existence of said first resource if the second resource with respect to other relevant resources has the first identifier associated herewith when one of said other resources is to be accessed by the computer system for display. Emens at col. 4, lines 22-34³.

27. In regards to **claim 29**, Emens discloses the method as claimed in claim 28 wherein step b) further includes retaining other resources having a relevance score higher than a threshold. Emens at col. 4, lines 52-4, 57-9.

28. In regards to **claim 30**, Emens discloses the method as claimed in claim 28, wherein step a) is implemented for a plurality of second resources belonging to a group (Emens at col. 4, lines

¹ The first selection of a URL by the user is interpreted as the first resource. The next URL selected by the user is interpreted as the second resource. The selection is a "declaration that...[it]...should be associated" because the links are determined by the user as having the desired information searched for. The association is then stored for the second resource in association with the first resource, which are both stored with the original query.

² The counts are interpreted as the relevancy score. The more counts, the more relevant.

³ The second user is presented with a list of relevant links associated with the same or similar query as determined by another user. These links are displayed (signaled) to the user and each link is different (distinct) from each other (from the first site).

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12-17), and step b) further comprises identifying other relevant resources with respect to the set of second resources of the group. Emens at col. 5, lines 3-9.

29. In regards to **claim 31**, Emens discloses the method as claimed in claim 28, wherein step b) is performed in response to an association made in step a). Emens at col. 5, lines 3-9⁴.

30. In regards to **claim 32**, Emens discloses the method of claim 28 wherein step b) is performed subsequent to the access envisaged in step c) to determine whether the other resource which it has accessed is another relevant resource with respect to the second resource. Emens at col. 3, lines 56-60; col. 4, lines 44-6⁵.

31. In regards to **claim 33**, Emens discloses the method as claimed in claim 28, wherein step b) is performed by supplying an identifier of the second resource to a server adapted to execute the relevant scoring process. Emens at col. 4, lines 51-59⁶.

32. In regards to **claim 36**, Emens discloses the method as claimed in claim 28, wherein step a) is performed by a pointing input device on graphical objects representative of the first and second resources. Emens at col. 3, lines 44-6⁷.

⁴ The identifying step is interpreted as being performed in response to the association step because the identifying and cross-referencing being performed utilizes the associations made by the user in the first step by the user clicking on the desired links.

⁵ The identification occurs each time a user makes a query, thus the displaying displays relevant links according to the previously associated resources.

⁶ The link (identifier) of the second resource is given to the system to determine counts of it (relevance). The identifications are made by the number of counts (identifying relevant sites) above a threshold.

⁷ A web browser is a graphical user interface, which requires a pointing input device. The links displayed on the web browser are interpreted as "graphical objects" representative of the first and second resources.

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Claim Rejections - 35 USC § 103

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. **Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens et al. (US Patent 6,832,218) hereinafter "Emens", in view of Kolluri et al. (US Patent Pub 2003/0101286) hereinafter "Kolluri".**

35. In regards to **claim 34**, Emens does not expressly disclose wherein the relevant scoring process is adapted to identify other resources relevant with respect to at least one intermediate resource with respect to which the second resource is predetermined as being relevant.

36. Kolluri discloses a weighting process that includes an intermediate link for determining strengths of each other links. Kolluri at para. 0008, lines 4-8.

37. Emens and Kolluri are analogous art because they are directed to the same field of endeavor of associations over the Internet.

38. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the method of Emens by making the relevant scoring process identify other resources relevant with respect to at least one intermediate resource with respect to which the second resource is predetermined as being relevant, as taught by Kolluri.

39. The motivation for doing so would have been because it allows for stronger relationship calculations and more reliable relevance scores. Kolluri at para. 0005.

40. In regards to **claim 35**, Emens and Kolluri disclose the method as claimed in claim 34, wherein step c) further comprises displaying, in the vicinity of an area for displaying resources, representations of links to at least certain among the first resource forming said signaling information and resources that are relevant with respect to said intermediate resources. Emens at col. 4, lines 31-4⁸.

Response to Amendment

Specification

41. Applicant's amendment to the abstract is acknowledged. Consequently, objection to the specification is withdrawn.

Objection to claims 31-38 for Minor Informalities

42. Applicant's amendment to claims 31-38 to address multiple dependency issues is acknowledged. Consequently, the objection to claims 31-38 is withdrawn. Claims 31-38 have been considered on the merits above.

Rejection of Claims 28-30 under 35 U.S.C 112, Second Paragraph

43. Applicant's amendment to claims 28-30 is acknowledged. However, further amendments to the claims have raised new issues of indefiniteness as described above in the rejection.

⁸ The search results displays links to sites (representations of links to at least certain among the first resources forming said signaling information) which are shown as the alternate list and the relevant list (resources relevant with respect to said intermediate resources).

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Consequently, the rejection to claims 28-30 under 35 U.S.C. 112, second paragraph is maintained.

Rejection of Claims 28-30 under 35 U.S.C 101

44. Applicant's amendment to claims 28-30 is acknowledged. However, the amendments do not overcome the issues under 35 U.S.C. 101 as described in the rejection above. Consequently, the rejection to claims 28-30 under 35 U.S.C. 101 is maintained.

Response to Arguments

Rejection of claims 28-30 under 35 U.S.C. 102(e)

45. Applicant's arguments in regards to the rejections to claims 28-30 under 35 U.S.C. 102(e), have been fully considered but are moot in view of the new grounds of rejection as necessitated by Applicant's amendments.

Conclusion

46. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

47. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

48. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Le whose telephone number is 571-272-7970. The examiner can normally be reached on Mon-Thurs : 9:30am-6pm, Fri: 8am-4:30pm.

49. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

50. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Le
Art Unit 2163
July 6, 2007


WILSON LEE
PRIMARY EXAMINER